

## REMARKS

In the Office Action of February 21, 2007, the abstract and paragraph [0016] of the specification were objected to because of informalities. In response, Applicant has amended the abstract and the paragraph [0016] of the specification accordingly. Thus, Applicant respectfully requests that these objections be withdrawn.

In addition, claims 6, 7, 9-19 and 21-40 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 6,459,442 B1 (hereinafter “Edwards et al.”). Furthermore, claims 8 and 20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Edwards et al. in view of U.S. Patent Number 6,184,885 B1 (hereinafter “DeStefano”).

In response, Applicant has amended the independent claims 6 and 18 to correct minor errors. As amended, Applicant respectfully asserts that the independent claims 6, 18 and 30 are not obvious in view of the cited reference of Edwards et al., as explained below. In view of the claim amendments and the following remarks, Applicant respectfully requests that the independent claims 6, 18 and 30, as well as their dependent claims 7-17, 19-29 and 31-40, be allowed.

### 1. Patentability of Independent Claims 6, 18 and 20

The Office Action has rejected the independent claims 6, 18 and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Edwards et al. However, a *prima facie* case of obviousness for the amended independent claims 6, 18 and 20 cannot be established. Thus, Applicant respectfully asserts that the amended independent claims 6, 18 and 20 are not obvious in view of the cited reference of Edwards et al., and requests that these independent claims be allowed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As correctly stated on pages 4 and 5 of the Office Action with reference to claim 6, the cited reference of Edwards et al. "does not teach said display-and-control graphic [element] that can selectively display a portion of said local drawing surface such that some of said local drawing surface is not displayed." However, the Office Action asserts that "[c]ropping and clipping are well know terms used to describe resizing, trimming, and hiding of certain areas of a display" and that "[i]t is also well known in the art that cropping and clipping can occur by the user selecting a portion of a display to be viewed." The Office Action then asserts that "[i]t would have been obvious to one skilled in the art at the time the invention was made to have included cropping or clipping with Edwards' system to allow a user to focus on a primary subject and sharpening an area by cropping or clipping simply creates a clearer, better looking layout which is important when paying attention to detail is critical."

However, the proposed modification would render the system of Edwards et al. unsatisfactory for its intended purpose. Thus, Applicant respectfully asserts that the amended independent claim 6 is not obvious in view of the cited reference of Edwards et al.

As described in the abstract, the intended purpose of Edwards et al. is to provide a freeform display editing system that groups freeform strokes into one or more segments

on a display. The segments of Edwards et al. have various properties, which are described throughout the disclosure of Edwards et al. Thus, the properties of the segments can be viewed as an important aspect of the intended purpose of Edwards et al.

5           As stated in column 10, lines 53-54, one of the properties of the segments is that “segments are not permitted to overlap in order to ensure strokes on the display remain visible.” The Edwards et al. then describes how a segment is pushed away and decreased in size when the segment has collided with another segment. If the system of Edwards et al. is modified in the manner suggested in the Office Action, then all the strokes on the  
10   display will not remain visible, which would not be desirable as described in Edwards et al.

          As illustrated in Figs. 17 and 18, another property of the segments is that a segment can be joined with another segment or split into smaller segments. However, if  
15   the system of Edwards et al. is modified in the manner suggested in the Office Action, then this property is probably not feasible since it is not apparent how the strokes that are hidden will be treated when two segments are joined or when a segment is split into two segments. Applicant also notes herein that the Office Action has not shown how the system of Edwards et al. can be modified in the suggested manner and still have all the  
20   properties described with respect to segments (e.g., joining and splitting). Applicant respectfully submits that there is no reasonable expectation of success to modify the system of Edwards et al. in the suggested manner such that segments still have all the properties described so that the intended purpose of Edwards et al. is not compromised.

25           Since there is no suggestion or motivation and no reasonable expectation of success to modify the system of Edwards et al. in the manner suggested in the Office Action, Applicant respectfully asserts that the amended independent claim 6 is not obvious in view of the cited reference of Edwards et al., and requests that this independent claim 6 be allowed.

The above remarks are also applicable to the independent claims 18 and 30, which recite similar limitations. Thus, Applicant respectfully asserts that the independent claims 18 and 30 are also not obvious in view of the cited reference of Edwards et al., and requests that these independent claims 18 and 30 be allowed.

5

2. Patentability of Dependent Claims 7-17, 19-29 and 31-40

Each of the dependent claims 7-17, 19-29 and 31-40 depends on one of the independent claims 6, 18 and 30. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for at least the same reasons as their respective base claims.

As an example, the dependent claim 9 recites “*wherein a first graphic element of said additional graphic elements in said display-and-control graphic element is functionally linked with a second graphic element of said different graphic elements on said global drawing surface,*” which is not disclosed in Edwards et al. The Office Action on page 5 cites elements (a) and (b) in Fig. 17 and column 10, lines 36-52 to assert that Edwards et al. teaches the limitations as recited in claim 9. As illustrated in Fig. 17 of Edwards et al., the first element (a) in Fig. 17 is in the segment 426d and the second element (b) in Fig. 17 is in the segment 426e. Thus, the second element (b) is not on a “global drawing surface,” as recited in claim 9. Thus, claim 9 cannot be obvious in view of Edwards et al. These remarks are also applicable to claims 21 and 32, which recite similar limitations.

25

As another example, the dependent claim 10 recites “*wherein said first graphic element in said display-and-control graphic element and said second graphic element on said global drawing surface are configured such that said first graphic element is controlled by said second graphic element,*” which is not disclosed in Edwards et al. The Office Action on page 6 states that “Edwards teaches that the segment controller, regardless if it is the first or second graphic element, can controls the output of a selected

30

segment.” However, the segment controller of Edwards et al. is not a graphic element. The segment controller (404) is described in column 4, lines 62-66, in the system architecture overview section and is illustrated in Fig. 4. Clearly, the segment controller (404) is not a graphic element displayed on the display (104). Thus, the segment controller (404) is not a graphic element in a “display-and-control graphic element” or a graphic element on a “global drawing surface”, as recite in claim 10. Thus, claim 10 cannot be obvious in view of Edwards et al. These remarks are also applicable to claims 22 and 33, which recite similar limitations.

As another example, the dependent claim 11 recites “*wherein said first graphic element in said display-and-control graphic element and said second graphic element on said global drawing surface are configured such that said second graphic element is controlled by said first graphic element,*” which is not disclosed in Edwards et al. The Office Action on page 6 states that “Edwards teaches that the segment controller, regardless if it is the first or second graphic element, can controls the output of a selected segment.” However, as stated above, the segment controller of Edwards et al. is not a graphic element. Thus, the segment controller (404) is not a graphic element in a “display-and-control graphic element” or a graphic element on a “global drawing surface”, as recite in claim 11. Thus, claim 11 cannot be obvious in view of Edwards et al. These remarks are also applicable to claims 23 and 34, which recite similar limitations.

As another example, the dependent claim 14 recites “*further comprising a second display-and-control graphic element on said local drawing surface of said display-and-control graphic element such that said second display-and-control graphic element is located within said display-and-control graphic element, said second display-and-control graphic element including a graphic element that is functionally linked with a particular graphic element, said particular graphic element being one of said different graphic elements on said global drawing surface or one of said additional graphic elements in said display-and-control graphic element,*” which is not disclosed in Edwards et al. The Office Action on page 6 cites Fig. 17 and column 10, lines 36-52, to assert that Edwards

et al. teaches the recited limitations of claim 14. However, as shown in Fig. 17, none of the segments 426d, 426e and 426f is located within another segment. Consequently, Edwards et al. does not disclose “*a second display-and-control graphic element on said local drawing surface of said display-and-control graphic element such that said second display-and-control graphic element is located within said display-and-control graphic element*” (emphasis added). Thus, claim 14 cannot be obvious in view of Edwards et al. These remarks are also applicable to claims 26 and 37, which recite similar limitations.

As another example, the dependent claim 17 recites “*wherein said second display-and-control graphic element is one of a set of display-and-control graphic elements, each display-and-control graphic element of said set being configured to be activated to modify a unique property of said particular graphic element,*” which is not disclosed in Edwards et al. The Office Action on page 6 cites column 5, lines 7-13, to assert that Edwards et al. teaches the recited limitations of claim 17. However, the cited passage of Edwards et al. does not disclose that that multiple segments modify properties of a same graphic element, i.e., stroke. Thus, claim 17 cannot be obvious in view of Edwards et al. These remarks are also applicable to claims 29 and 40, which recite similar limitations.

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,

Denny Jaeger

Date: August 21, 2007

By: /thomas h. ham/

Thomas H. Ham

Registration No. 43,654

Telephone: (925) 249-1300